

REMARKS

This is a full and timely response to the outstanding Final Office Action mailed January 29, 2003. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

1. Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-23 remain pending in the present application. In addition, new claims 24-37 have been added. The foregoing amendment and additions add no new matter to the present application. Please see the appendix for the "Annotated Version of Modified Claims to Show Changes Made."

2. Response to Rejection of Claims 1-4 Under 35 U.S.C. § 103(a)

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* (U.S. Patent No. 6,006,159) in view of Applicant's own disclosure. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Further, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant's disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

a. Claim 1

As provided in independent claim 1, Applicant claims:

1. A system for reporting impending vehicle deliveries, comprising:
memory storing a vehicle schedule, said vehicle schedule identifying packages that are to be respectively delivered to a plurality of recipients by a vehicle during a first time period and indicating an order that said vehicle is expected to deliver said packages;
a first communications device configured to establish communication with remote communications devices; and
a system manager configured to analyze said vehicle schedule and to determine, based on said order, a second time period that said

vehicle is expected to deliver one of said packages, said system manager further configured to transmit a notification message for a respective one of said recipients of said one of said packages via said first communications device, said notification message identifying said second time period,

wherein said second time period is within said first time period.

(Emphasis added).

Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 1 recites a system comprising a system manager configured to analyze a vehicle schedule that identifies packages that are to be delivered to the respective recipients of the packages in a certain order by a vehicle. The proposed combination of *Schmier* in view of Applicant's disclosure would not result in the claimed system for at least the reason that the passenger delivery system in *Schmier* does not "identify[] packages that are to be respectively delivered to a plurality of recipients by a vehicle," does not "indicat[e] an order that said vehicle is expected to deliver said packages," and does not "determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages," as recited in claim 1.

Rather, *Schmier* appears to disclose a passenger delivery system in which the passenger vehicle, such as a passenger bus, makes scheduled fixed stops at different stopping points regardless of the identity or quantity of the passengers onboard. Accordingly, *Schmier* suggests an approach for reporting the arrival of the vehicle itself and not the individual passengers onboard the vehicle. Therefore, *Schmier* does not "identify[] packages that are to be respectively delivered to a plurality of recipients by a vehicle," "indicat[e] an order that said vehicle is expected to deliver said packages," or "determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages."

Of course, when an element is not shown in any references, then the USPTO also has the burden of establishing that there was some motivation to modify the teaching of the prior art to meet the claim limitations. The Federal Circuit has observed that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re, Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). This pronouncement of the Federal Circuit is particularly-relevant to the present situation.

If *Schmier* were modified by combining it with the other reference(s) cited, *Schmier* would be inoperable for its intended purpose of “notifying a passenger waiting for public transit vehicle of the arrival time of the vehicle at a public stop” where the “[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route,” because the package delivery system cited by the Examiner in the other references does not make public transit stops. See col. 3, lines 13-15; col. 9, lines 23-25. Note, the package delivery system cited in Applicant’s disclosure is a package delivery service that makes deliveries to residences and places of business. Hence, *Schmier* provides no motivation or teaching to incorporate a delivery system that reports the arrival of individual passengers or packages such as the claimed invention. Accordingly, the suggested modification to *Schmier* in the Examiner’s rejection is unwarranted and improper. *Carl Schenck, A.G., v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983).

Further, claim 1 specifically features a “system manager further configured to transmit a notification message for a respective one of said recipients of said one of said packages.” However, the passenger delivery system of *Schmier* does not account for intended recipients of its cargo, since the cargo primarily comprises people who reach their final destination on their own. As a result, this feature of transmitting notification messages for the respective recipient is not disclosed in *Schmier* and is not cured by the cited prior art. Therefore, the proposed combination of *Schmier* in view of Applicant’s disclosure simply would not result in Applicant’s claimed invention.

Hence, the rejection of claim 1 should be withdrawn.

b. Claims 2-3

Because independent claim 1 is allowable over the prior art of record, dependent claims 2-3 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 2-3 contain all the elements/features of independent claim 1. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Therefore, claims 2-3 are not obvious under the proposed combination of *Schmier* in view of Applicant’s own disclosure, and the rejection should be withdrawn.

c. Claim 4

Because independent claim 1 is allowable over the prior art of record, dependent claim 4 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim 4 contains all the elements/features of independent claim 1. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claim 4 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. Specifically, the feature “wherein said vehicle schedule identifies each recipient that is to receive at least one of said packages, said notification message identifying each of said packages to be received by one of said recipients during said first time period,” as recited in claim 4, is not disclosed or suggest by either *Schmier* or Applicant’s disclosure.

Further, the office action states that “[o]bviously, without a recipient, there would be no delivery,” and therefore the feature “that said vehicle schedule identifies each recipient that is to receive at least one of said packages” is inherently taught by the prior art. However, in *Schmier*, a recipient is not accounted for in the disclosed passenger delivery system, since the customers of the service are primarily the cargo (*e.g.*, passengers) in the vehicle, and they do not need to be delivered to another party or recipient. Accordingly, by Examiner’s reasoning, *Schmier* does not provide the necessary motivation or teaching to incorporate all of the claimed features.

Hence, the rejection of claim 4 should be withdrawn.

3. Response to Rejection of Claims 5-7, 9, 10, 12-19, and 21 Under 35 U.S.C. § 103(a)

Claims 5-7, 9, 10, 12-19, and 21 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* (U.S. Patent No. 6,006,159) in view of Applicant’s own disclosure and *Hitchcock*, “The Big Hiccup” (April 1996). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Further, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant’s disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

a. Claim 5

As provided in independent claim 5, Applicant claims:

5. A system for reporting impending vehicle deliveries, comprising:
memory storing package data identifying a plurality of packages that are to be respectively delivered to a plurality of recipients;
a first communications device configured to establish communication with remote communications devices; and

a system manager configured to detect when one of said packages has been assigned to a vehicle for delivery to one of said recipients, said system manager further configured to transmit a notification message for a respective one of said recipients via said first communications device at a time after a detection that said one of said packages for said one of said recipients has been assigned to said vehicle is determined.

(Emphasis added).

Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 1 recites a system comprising "a system manager configured to detect when one of said packages has been assigned to a vehicle for delivery to one of said recipients." The proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* would not result in the claimed system for at least the reason that the passenger delivery system in *Schmier* does not detect when a passenger is assigned or boards a public transit vehicle and provides no motivation to do so.

Rather, *Schmier* appears to disclose a passenger delivery system in which the passenger vehicle, such as a passenger bus, makes scheduled stops at different stopping points regardless of the identity or quantity of the passengers onboard. Accordingly, *Schmier* seemingly suggests an approach for reporting the arrival of the vehicle itself and not the individual passengers onboard the vehicle. Therefore, *Schmier* does not "detect when one of said packages has been assigned to a vehicle," as recited in claim 5.

Of course, when an element is not shown in any references, then the USPTO also has the burden of establishing that there was some motivation to modify the teaching of the prior art to meet the claim limitations. The Federal Circuit has observed that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the

desirability of the modification.” *In re, Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). This pronouncement of the Federal Circuit is particularly-relevant to the present situation.

If *Schmier* were modified by combining it with the other references cited, *Schmier* would be inoperable for its intended purpose of “notifying a passenger waiting for public transit vehicle of the arrival time of the vehicle at a public stop” where the “[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route,” because the package delivery system of the other references cited by the Examiner does not make public or fixed transit stops. *See* col. 3, lines 13-15; col. 9, lines 23-25. Diversely, the other cited references disclose a package delivery service that makes deliveries to residences and places of business. Hence, *Schmier* provides no motivation or teaching to incorporate a delivery system that detects individual passengers or packages such as the claimed invention. Thus, the suggested modification to *Schmier* in the Examiner’s rejection is unwarranted and improper. *Carl Schenck, A.G., v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983).

In addition, claim 5 specifically features “a system manager configured to detect when one of said packages has been assigned to a vehicle for delivery to one of said recipients.” Note, *Schmier* does not disclose, teach, or suggest the feature of a “system manager further configured to transmit a notification message for a respective one of said recipients via said first communications at a time after a detection that said one of said packages for said one of said recipients has been assigned to said vehicle is determined.” On the contrary, *Schmier* discloses broadcasting public announcements of the progress of a particular transit vehicle in general. Moreover, these claimed features that are not not disclosed in *Schmier* are also not cured by the cited prior art. Therefore, the proposed combination of *Schmier* in view of Applicant’s disclosure and *Hitchcock* simply would not result in Applicant’s claimed invention.

Accordingly, the rejection of claim 5 should be withdrawn.

b. Claims 6-9

Because independent claim 5 is allowable over the prior art of record, dependent claims 6-9 (which depend from independent claim 5) are allowable as a matter of law for at least the reason that the dependent claims 6-9 contain all the elements/features of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

c. Claim 10

Because independent claim 5 is allowable over the prior art of record, dependent claim 10 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that the dependent claim 10 contains all the elements/features of independent claim 5. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent claim 10 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature “wherein said package data indicates that said packages are to be delivered by said vehicle and indicates an order that said vehicle is expected to deliver said packages, and wherein said system manager is further configured to determine, based on said order, that said one package is expected to be delivered during a particular time period, said notification message indicating that said one package is expecting to be delivered during said particular time period,” as recited in claim 10, is not disclosed or suggest by either *Schmier*, Applicant’s disclosure, or *Hitchcock*.

For example, the passenger delivery system of *Schmier* broadcasts announcements about the progress of a transit vehicle based upon information about the transit vehicle itself and not the cargo contained within the transit vehicle. In other words, if the transit vehicle in *Schmier* contained no cargo, the announcements about its progress would not be potentially affected, since the information in the announcements are not seemingly based upon the contents of the transit vehicle. Hence, *Schmier* makes no motivation or teaching to incorporate the claimed features of determining based on the order of delivery whether a package is to be delivered during a particular time period and indicating this information in a notification message, as claimed.

Further, a passenger notification system of *Schmier* does not disclose, teach, or suggest an order for delivering and reporting the arrival of individual packages that can be incorporated or combined with a barcode system of *Hitchcock* to result in the system of claim 10, since *Schmier* does not report the arrival of the cargo contained on its public transit vehicles. Rather, *Schmier* seemingly contemplates tracking the public transit vehicles themselves and not the cargo contained within. Therefore, the proposed combination of *Schmier* in view of Applicant’s disclosure and *Hitchcock* simply would not result in Applicant’s claimed invention.

Accordingly, the rejection of claim 10 should be withdrawn.

d. Claim 12

As provided in independent claim 12, Applicant claims:

12. A method for reporting impending vehicle deliveries, comprising the steps of:
receiving a plurality of packages;
assigning each of said packages to a vehicle;
determining an order that said vehicle is to deliver said packages;
determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient;
causing a notification message to be transmitted to said recipient based on said determining a first time period step;
indicating said first time period via said notification message;
simultaneously transporting each of said packages via said vehicle; and
transporting said one package to a premises of said recipient via said vehicle.

(Emphasis added).

Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 12 recites a method comprising the steps of "determining, based on said order [of delivery], a first time period that said vehicle is expected to deliver one of said packages to a recipient"; "causing a notification message to be transmitted to said recipient based on said determining a first time period step"; and "transporting said one package to a premises of said recipient via said vehicle."

The proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* would not result in the claimed method for at least the reason that the passenger delivery system in *Schmier* does not make deliveries to recipients, does not suggest the steps of "determining, based on said order [of delivery], a first time period that said vehicle is expected to deliver one of said packages to a recipient"; "causing a notification message to be transmitted to said recipient based on said determining a first time period step" and "transporting said one package to a premises of said recipient via said vehicle," as recited in claim 12.

Rather, *Schmier* appears to disclose a passenger delivery system in which the passenger vehicle, such as a passenger bus, makes scheduled stops at different stopping points regardless of the identity, quantity, or other characteristics of the passengers onboard. Accordingly, *Schmier* seemingly suggests an approach for tracking the vehicle itself and not the individual passengers onboard the vehicle. Therefore, *Schmier* does not disclose, teach, or suggest the steps of

“determining, based on said order [of delivery], a first time period that said vehicle is expected to deliver one of said packages to a recipient”; “causing a notification message to be transmitted to said recipient based on said determining a first time period step” and “transporting said one package to a premises of said recipient via said vehicle.”

Of course, when an element is not shown in any references, then the USPTO also has the burden of establishing that there was some motivation to modify the teaching of the prior art to meet the claim limitations. The Federal Circuit has observed that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re, Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). This pronouncement of the Federal Circuit is particularly-relevant to the present situation.

If *Schmier* were modified by combining it with the other reference(s) cited, *Schmier* would be inoperable for its intended purpose of “notifying a passenger waiting for public transit vehicle of the arrival time of the vehicle at a public stop” where the “[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route” because the package delivery system of the other references cited by the Examiner does not make public transit stops. *See* col. 3, lines 13-15; col. 9, lines 23-25. Note, the package delivery system cited in Applicant’s disclosure is a package delivery service that makes deliveries to residences and places of business. However, *Schmier* provides no motivation or teaching to incorporate a delivery system that makes deliveries to residences or businesses, since *Schmier* seemingly only contemplates the use of a public transit delivery system for broadcasting arrival information about public transit vehicles. Hence, the suggested modification to *Schmier* in the Examiner’s rejection is unwarranted and improper. *Carl Schenck, A.G., v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983).

In addition, a passenger notification approach of *Schmier* does not disclose, teach, or suggest an order for delivering and reporting the arrival of individual packages that can be incorporated or combined with a barcode system of *Hitchcock* to result in the method of claim 12, since *Schmier* does not track the cargo contained on its public transit vehicles. Rather, *Schmier* contemplates reporting the arrival of the public transit vehicles themselves, regardless of the contents contained within in the vehicle. Therefore, the proposed combination of *Schmier* in view of Applicant’s disclosure and *Hitchcock* simply would not result in Applicant’s claimed invention.

Accordingly, the rejection of claim 12 should be withdrawn.

e. Claims 13-15

Because independent claim 12 is allowable over the prior art of record, dependent claims 13-15 (which depend from independent claim 12) are allowable as a matter of law for at least the reason that the dependent claims 13-15 contain all the steps of independent claim 12. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

f. Claim 16

As provided in Applicant's independent claim 16, Applicant claims:

16. A method for reporting impending vehicle deliveries, comprising the steps of:
receiving a package for delivery to a premises of a recipient;
assigning said package to a vehicle;
detecting when said package is assigned to said vehicle;
producing a notification message based upon said detecting step, said notification message indicating a time period in which said package is expected to be delivered at said premises;
transmitting said notification message to a recipient communication device; and
transporting said package to said premises via said vehicle.

(Emphasis added).

Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 16 recites a method comprising the steps of "receiving a package for *delivery to a premises of a recipient*"; "detecting when said package is assigned to said vehicle"; "producing a notification message based upon said detecting step"; "transmitting said notification message to a *recipient communication device*; and transporting said packages *to said premises* via said vehicle." (Emphasis Added).

The proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* would not result in the claimed method for at least the reason that the passenger delivery process in *Schmier* apparently does not deliver packages or passengers to the premises of recipients, does not detect when a passenger boards a transit vehicle, and does not transmit notification messages to communication devices located at a recipient's premises, as expressed in claim 16. Further, *Schmier* does not provide the proper motivation to do so.

Rather, *Schmier* appears to disclose a passenger delivery system in which the passenger vehicle, such as a passenger bus, makes scheduled stops at different stopping points regardless of the identity or quantity of the passengers onboard. Accordingly, *Schmier* suggests an approach for tracking the arrival of the vehicle itself and not the individual passengers onboard the vehicle. Therefore, *Schmier* does not feature the steps of “receiving a package for delivery to a premises of a recipient”; “detecting when said package is assigned to said vehicle”; “producing a notification message at a time after said detecting step”; “transmitting said notification message to a communication device located at said premises; and transporting said packages to said premises via said vehicle.”

Of course, when an element or step is not shown in any references, then the USPTO also has the burden of establishing that there was some motivation to modify the teaching of the prior art to meet the claim limitations. The Federal Circuit has observed that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re, Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). This pronouncement of the Federal Circuit is particularly-relevant to the present situation.

If *Schmier* were modified by combining it with the other reference(s) cited, *Schmier* would be inoperable for its intended purpose of “notifying a passenger waiting for public transit vehicle of the arrival time of the vehicle at a public stop” where the “[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route,” because the package delivery system cited in the other references by the Examiner does not make public transit stops. *See* col. 3, lines 13-15; col. 9, lines 23-25. Note, the package delivery system cited in Applicant’s disclosure is a package delivery service that makes deliveries to residences and places of business. However, *Schmier* provides no motivation or teaching to incorporate a delivery system that makes deliveries to residences or businesses, since *Schmier* seemingly only contemplates the use of a public transit delivery system for broadcasting arrival information about public transit vehicles. Hence, the suggested modification to *Schmier* in the Examiner’s rejection is unwarranted and improper. *Carl Schenck, A.G., v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983).

Further, a passenger notification system of *Schmier* does not disclose, teach, or suggest reporting the delivery of packages by “transmitting said notification message to a communication device located at said premises,” since *Schmier* does not track the particular cargo contained on its

public transit vehicles and does not make deliveries to a passenger's premise, for example. Therefore, the proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* simply would not result in Applicant's claimed invention.

In addition, a passenger notification approach of *Schmier* does not disclose, teach, or suggest a system for delivering and reporting the arrival of individual packages to a recipient's premises that can be incorporated or combined with a barcode system of *Hitchcock* to result in the method of claim 16, since *Schmier* does not track the cargo contained on its public transit vehicles. Rather, *Schmier* contemplates reporting the arrival of the public transit vehicles themselves at public or fixed transit stops, regardless of the contents contained within in the vehicle. Therefore, the proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* simply would not result in Applicant's claimed invention.

Accordingly, the rejection of claim 16 should be withdrawn.

g. Claims 17-23

Because independent claim 16 is allowable over the prior art of record, dependent claims 17-23 (which depend from independent claim 16) are allowable as a matter of law for at least the reason that the dependent claim 17 contains all the steps of independent claims 16-23. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

4. Response to Rejection of Claim 8 Under 35 U.S.C. § 103(a)

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* in view of Applicant's own disclosure, *Hitchcock*, and Bar Code (June 1999). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that since independent claim 5 is allowable over the prior art of record, dependent claim 8 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that dependent claim 8 contains all features/elements of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

5. Response to Rejection of Claims 11 and 20 Under 35 U.S.C. § 103(a)

Claims 11 and 20 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* in view of Applicant's own disclosure, *Hitchcock*, and *Fruchey* (U.S. Patent No. 4,297,672). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Further, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the applicant's disclosure. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

a. Claim 11

Applicant respectfully submits that since independent claim 5 is allowable over the prior art of record, dependent claim 11 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that dependent claim 11 contains all the features/elements of independent claim 5. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent claim 11 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature wherein "said system manager is further configured to determine when said vehicle is within a predefined proximity of a premises of said one recipient based on signals transmitting from said vehicle, said system manager further configured to transmit a second notification message when said vehicle is within said predefined proximity" as recited in claim 11, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or *Fruchey*. Particularly, since *Schmier* does not seemingly account for a transit vehicle approaching the premises of package recipients, there is no motivation to incorporate the claimed features of "determin[ing] when said vehicle is within a predefined proximity of a premises" and "transmit[ing] a second notification message when said vehicle is within said predefined proximity," as recited in claim 11. Therefore, the proposed combination of *Schmier* in view of Applicant's disclosure, *Hitchcock*, and *Fruchey*

simply would not result in Applicant's claimed invention. Moreover, without the proper motivation or teachings, the suggested modification to *Schmier* in the Examiner's rejection is unwarranted and improper. *Carl Schenck, A.G., v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983).

Accordingly, the rejection of claim 11 should be withdrawn.

b. Claim 20

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 20 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that dependent claim 20 contains all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claim 20 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the steps of "determining when said vehicle is within a predetermined proximity of said premises; and transmitting a second notification message in response to said determining step" as recited in claim 20, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or *Fruchey*. Particularly, since a transit vehicle in the *Schmier* system does not suggest delivering packages to the premises of package recipients, there is no motivation to incorporate the claimed features of "determining when said vehicle is within a predefine proximity of a premises" and "transmitting a second notification message in response to said determining step," as recited in claim 20. Therefore, the proposed combination of *Schmier* in view of Applicant's disclosure, *Hitchcock*, and *Fruchey* simply would not result in Applicant's claimed invention. Moreover, without the proper motivation or teachings, the suggested modification to *Schmier* in the Examiner's rejection is unwarranted and improper. *Carl Schenck, A.G., v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed. Cir. 1983).

Accordingly, the rejection of claim 20 should be withdrawn.

6. Response to Rejection of Claims 22-23 Under 35 U.S.C. § 103(a)

Claims 22-23 have been rejected under 35 U.S.C. §103(a) as being purportedly unpatentable over *Schmier* in view of Applicant's own disclosure, *Hitchcock*, and *Nathanson* (U.S. Patent No. 5,

122, 959). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Further, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant's disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claims 22-23 (which depend from independent claim 16) are allowable as a matter of law for at least the reason that dependent claims 22-23 contain all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

7. New Claims 24-37

Claims 24-37 have been newly added to further define and/or clarify the scope of the invention, and are based on subject matter that is explicit and/or inherent within the description of the specification and/or inherent within the drawings. Applicant submits that no new matter has been added in the new claims 24-37, and that new claims 24-37 are allowable over the cited prior art.

a. Claims 24-27

Specifically, Applicant's independent claim 24 recites a system comprising the elements of “means for determining, based on said order [of delivery], a first time period that said vehicle is expected to deliver one of said packages to a recipient”; “means for causing a notification message to be transmitted to said recipient, said notification message indicating said first time period”; and “means for transporting said one package to a premises of said recipient via said vehicle.”

The proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* would not result in the claimed system for at least the reason that the passenger delivery system in *Schmier* does not make deliveries to recipients, does not suggest the elements of “means for determining, based on said order [of delivery], a first time period that said vehicle is expected to deliver one of said packages to a recipient”; “means for causing a notification message to be

transmitted to said recipient” and “means for transporting said one package to a premises of said recipient via said vehicle,” as recited in claim 24. Further, *Schmier* does not provide the motivation to do so.

Therefore, Applicant respectfully requests the Examiner to enter and allow claim 24 and claims 25-27 which depend from claim 24.

b. Claims 28-35

Applicant's independent claim 28 recites a system comprising the elements of “means for receiving a package for *delivery to a premises of a recipient*”; “means for detecting when said package is assigned to said vehicle”; “means for producing a notification message based upon said detecting step”; “means for transmitting said notification message to a *recipient communication device*; and means for transporting said packages *to said premises* via said vehicle.” (Emphasis Added).

The proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock* would not result in the claimed system for at least the reason that the passenger delivery process in *Schmier* apparently does not deliver packages or passengers to the premises of recipients, does not detect when a passenger boards a transit vehicle, and does not transmit notification messages to communication devices located at a recipient's premises, as expressed in claim 28. Further, *Schmier* does not provide the proper motivation to do so.

Therefore, Applicant respectfully requests the Examiner to enter and allow claim 28 and claims 29-35 which depend from claim 28.

c. Claims 36-37


Because independent claims 4 and 11 are allowable over the prior art of record, dependent claims 36-37 (which depend from independent claims 4 and 11 respectively) are allowable as a matter of law for at least the reason that the dependent claims 36-37 contain all the steps of independent claims 4 and 11. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

CONCLUSION

For at least the foregoing reasons, all rejections and objections have been rendered moot, accommodated, and/or traversed, and Applicant respectfully request that all outstanding rejections be withdrawn and that all pending claims 1-37 of this application be allowed to issue. If the Examiner has any comments regarding Applicant's response or intends to dispose of this matter in a manner other than a notice of allowance, Applicant requests that the Examiner telephone Applicant's undersigned agent.

Respectfully submitted,

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Docket No.: 50119-1060



ANNOTATED VERSION OF MODIFIED CLAIMS TO SHOW CHANGES MADE

The following is a marked up version of the amended claims, wherein brackets denote deletions and underlining denotes additions.

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1 1. (Once Amended) A system for reporting impending vehicle deliveries,
2 comprising:
3 memory storing a vehicle schedule, said vehicle schedule identifying packages
4 that are to be respectively delivered to a plurality of recipients by a vehicle during a first
5 time period and indicating an order that said vehicle is expected to deliver said packages;
6 a first communications device configured to establish communication with remote
7 communications devices; and
8 a system manager configured to analyze said vehicle schedule and to determine,
9 based on said order, a second time period that said vehicle is expected to deliver one of
10 said packages, said system manager further configured to transmit a notification message
11 for a respective one of said recipients of said one of said packages via said first
12 communications device, said notification message identifying said second time period,
13 wherein said second time period is within said first time period.

1 5. (Once Amended) A system for reporting impending vehicle deliveries,
2 comprising:
3 memory storing package data identifying a plurality of packages that are to be
4 respectively delivered to a plurality of recipients;
5 a first communications device configured to establish communication with remote
6 communications devices; and
7 a system manager configured to detect when one of said packages has been assigned to a
8 vehicle for delivery to one of said recipients, said system manager further configured to transmit
9 a notification message for a respective one of said recipients via said first communications
10 device [in response to] at a time after a detection that said one of said packages for said one of
11 said recipients has been assigned to said vehicle is determined.

1 16. (Once Amended) A method for reporting impending vehicle deliveries, comprising
2 the steps of:
3 receiving a package for delivery to a premises of a recipient;
4 assigning said package to a vehicle;
5 detecting when said package is assigned to said vehicle;
6 producing a notification message [in response to] based upon said detecting step; said
7 notification message indicating a time period in which said package is expected to be delivered
8 at said premises;
9 transmitting said notification message to a recipient communication device [located at
10 said premises]; and
11 transporting said package to said premises via said vehicle.